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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,141	03/19/2001	Hubertus V. Thomeer	56.0546CIP	1045

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EXAMINER

WONG, ALBERT KANG

ART UNIT

PAPER NUMBER

2635

DATE MAILED: 05/20/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/812,141

Applicant(s)

THOMEER ET AL.

Examiner

Albert K Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 24-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. This Office action is in response to the amendment filed February 23, 2004. Claims 24-46 are pending. Claims 1-23 have been cancelled and new claims 28-46 have been entered. The prior rejection of the claims have been withdrawn in view of the amendment. Since this application is a CIP of 09/536,953 (Patent 6,333,700), it is presumed that the claimed subject matter do not have the benefit of the earlier filing date. If applicant disagrees with the Examiners position, he is encouraged to provide specific support in the parent application.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 24-28, 30-39, and 41-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Zierof.

Regarding claims 24 and 25, Zierof teaches a downhole system using passive or active transponders (prid, rfid) for the actuation of downhole equipment. The rfid tags are provided on the casing joints and a reader/transmitter are provided on the moving tool. The tool transmits a signal to the tags and thus provides power to the tags. The tags respond with a signal that is decoded by the tool. Downhole equipment is actuated in response to the proper decoded signal. Rfid tags are considered to be non-acoustic transmitters and receivers.

Regarding claims 26-27, see col. 6, lines 1-20.

Regarding claim 28, the conveyance tool is a line (item 26).

Regarding claim 30, the moveable sleeve is shown in Figure 5, item 52.

Regarding claim 31, the claimed downhole tool is shown in Figure 1.

Regarding claim 32, steps a-d have been discussed in claim 24. The claimed identification code is taught in col. 10.

Regarding claims 33-39 and 41-42, these limitations have been addressed above.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 29 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zierof as applied to claims 32 above, and further in view of Aronstam.

Regarding claims 29 and 40, Zierof does not disclose that the first downhole structure is attached to a drop ball. The structure is moved within the well on a wireline or similar structure. Aronstam teaches the movement of Rfid tags located on ball structures that move in a well. The balls move within the well and communicate with other RF devices as the ball passes them. It would have been obvious that one may use a variety of means to move the communication devices within a well. Aronstam teaches an alternative embodiment.

6. Claims 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zierof.

Regarding claim 43, Zierof teaches a first downhole structure as a passive Rfid tag that receives a interrogation signal and transmits an id code. It also teaches a reader that corresponds to the second downhole structure with transmit/receive capability. When the Rfid tag is interrogated the responding signal is received by the second downhole structure. Thus, the first and the second structures receive signals from the other unit and responds in kind. The system in

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Zierof does not have a target code. It is well known in the passive transponder art that transponders may be addressable. Thus, a target code is sent and received. If the target code matches the code in the transponder, the transponder responds. It would have been obvious to include such codes for the advantage of only having the desired transponder respond to the inquiry. This would reduce interference and eliminate the need to decipher each transponder's response to the interrogation signal.

Regarding claim 44, since the actuation of the tool is in response to receiving a signal indicating the proper depth, it would have been obvious by sending a target code for the proper depth and the reception of the code indicating that the depth has been reached should result in the activation of the equipment.

Regarding claims 45 and 46, Zierof teaches the steps of returning a signal to the surface or storing the signal in response to the interrogation signal. If one is trying to determine the proper depth by trying to locate a code indicative of such, it would have been obvious to perform the function when such a depth is confirmed.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert K Wong whose telephone number is 703-305-8884. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Albert K. Wong  
May 13, 2004